

Appin No. 09/609,303
Amtd. Dated October 6, 2006
Response to Final Office Action of September 6, 2006

2

We also refer to the 3rd paragraph of page 11 and the 2nd paragraph of page 12 of the previous response dated 28 March 2006, which both make it very clear to the Examiner that each coded data portion is indicative of both the identity and the reference point, not simply just the coded data, and that this is not shown by the combination of Wolff et al in view of Sekunder et al.

In any event, the Applicant sets out below a detailed explanation as to why Wolff et al in view of Sekunder et al fails to disclose all the claim limitations of the claims, as required by MPEP 2143.

The Examiner has states at pages 4 and 5 that Sekunder *"meets the recitation of providing a form with a plurality of coded data [portions]...wherein each coded data portion being indicative of the at least one reference point of the form and the identity of the form...(see column 4, lines 10-60)"*.

Column 4, lines 10 to 60 describes that each coded data portion is indicative of a positional coordinate: *"plurality of dots 1 in FIG. 1 designating coordinates"*. However, there is absolutely no disclosure of the coded data of Sekunder being indicative of an identity of the form. Therefore, we respectfully submit that Sekunder only discloses a plurality of coded data portions, wherein each coded data portion being indicative of the at least one reference point of the form.

Therefore, as Wolff et al only teaches a single bar code that is indicative of an identity, the combination of the teaching of Sekunder only provides the teachings of a plurality of coded data portions each indicative of a reference point on the form, and a single coded data portion indicative of an identity of the form. Thus, the teachings of Wolff et al in view of Sekunder et al fail to disclose the claim limitation of each coded data portion being indicative of an identity of the form and of at least one reference point of the form, as required by claim 1.

The MPEP states at §2143 *"Basic Requirements of a Prima Facie Case of Obviousness"* that:

"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Wolff et al in view of Sekunder fails to meet the third basic requirement of a *prima facie* case of obviousness, as Wolff et al in view of Sekunder fails to teach all the claim limitations, in particular, each coded data portion being indicative of an identity of the form and of at least one reference point of the form. As all three basic requirements of a *prima facie* case of obviousness must be met in order to reject the claim as obvious, we respectfully submit the withdrawal of the obviousness rejection.

Furthermore, the Applicant argues that there is sufficient reasons why the teachings of Sekunder et al should not be combined with the teachings of Wolff et al.

Appln No. 09/609,303
Amdt. Dated October 6, 2006
Response to Final Office Action of September 6, 2006

3

In particular, the proposed modification by the Examiner changes the principle operation of Wolff et al. In particular, the principle operation of determining the position of the pen in Wolff et al was determined using a gyroscope. The modification of Wolff et al with the teaching of Sekunder renders the position being determined using on a coded data sensor. The gyroscope of Wolff et al has absolutely no purpose in the Examiner's proposed modified system. Therefore, the principle operation of Wolff et al has been changed.

MPEP 2143.01 (VI) states:

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)" (emphasis added)

The Examiner's modification of Wolff et al using the teaching of Sekunder et al has changed the principle operation of determining a position by Wolff et al. The gyroscope of Wolff et al has no purpose in the Examiner's proposed modification. The Applicant respectfully submits that as required by MPEP 2143.01(VI), due to the principle operation of Wolff et al being changed, the teachings of Wolff et al in view of Sekunder et al are not sufficient to render the claims *prima facie* obvious. We therefore respectfully request withdrawal of the obviousness rejection for all claims.

Reconsideration and withdrawal of this claim rejection is respectfully requested.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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